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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,221	02/20/2004	Joel Hanson	09710-1228	7408

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WorldCom, Inc.
Technology Law Department
1133 19th Street, NW
Washington, DC 20036

EXAMINER

WOO, STELLA L

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,221

Applicant(s)

HANSON ET AL.

Examiner

Stella L. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/04/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4, 7, 8 of U.S. Patent No. 6,697,474. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation application are broader than the claims in the patent.

For example, claim 1 of the present application is the same as claim 1 of the patent except it does not specify establishing "without selection by the called party for call establishment effected through the instant messaging client, if the called party is connected to a data network." Therefore, claim 1 of the present application is broader than claim 1 of the patent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Bogard (US 6,757,365).

Regarding claims 1 and 14, Bogard discloses a method for establishing communications between a calling party using a telephone connection (caller at telephone 300 or 301; col. 5, lines 32-41) and a called party using an instant messaging client (called party at computer 302 with an instant messaging service; col. 5, lines 55-67), comprising:

receiving a telephone call connection request from the calling party (telephone caller requests a voice connection via voice portal 310; col. 8, lines 25-33); and

establishing end-to-end voice communications between the telephone connection and the instant messaging client (computer user selects to establish the IM voice protocol session with the telephone caller; col. 8, lines 33-44).

Regarding claims 2-5, the user's instant messaging client supports voice communication with a voice telephone caller by translating between telephone audio and IM voice protocol format (col. 8, lines 33-44).

Regarding claim 6, a telephone caller requests a telephone connection with a logged in IM user by identifying a chat room name (col. 8, lines 1-33).

Regarding claim 7, Bogard discloses a method for establishing communications between a calling party using a telephone connection (caller at telephone 300 or 301; col. 5, lines 32-41) and a called party using an instant messaging client (called party at computer 302 with an instant messaging service; col. 5, lines 55-67), comprising:

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receiving a telephone call connection request from the calling party (telephone caller requests a voice connection via voice portal 310; col. 8, lines 25-33);

determining whether the instant messaging client is to receive voice communications (Instant Messaging server 308 determines whether the called party wishes to receive the incoming call at the called party's instant messaging client; col. 8, lines 29-38); and

responsive to the determining, establishing end-to-end voice communications between the telephone connection and the instant messaging client (if the called party respond that he/she wishes to accept the incoming call, then a voice connection is established; col. 8, lines 33-44).

Regarding claim 8, a user profile can include privacy settings, limits to callers from a buddy list, etc. (col. 11, lines 12-18; col. 12, lines 1-23).

Regarding claim 9, user's profile information indicates when a user's IM software can support voice communications (col. 8, lines 45-57).

Regarding claim 10, IM server 308 also determines if the user is currently online and able to receive the voice communication (col. 7, line 47 – col. 8, line 44).

Regarding claim 11, IM server 308 determines the called party's response to a prompt asking whether or not he/she wishes to accept the incoming call (col. 8, lines 29-44).

Regarding claim 12, the end-to-end voice communication is established via telephony gateway 307 and voice portal 310 (Figure 3).

Regarding claims 13, 15, telephony gateway 307 interfaces between telephone network 304 and Internet 306 (Figure 3).


Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lang et al. and Diamant et al. show other system which incorporate telephony with instant messaging.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stella L. Woo
Primary Examiner
Art Unit 2643